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Attorney Docket No. 83565/KNM
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Inventor(s):

Joseph A. Manico, et al.

METHOD OF USING A
PORTABLE SYSTEM FOR
CAPTURING IMAGES

Serial No.: 10/017,831

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Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

Group Art Unit: 2612

Examiner: James M. Hannett

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Karen J. Wacenske
Karen J. Wacenske

6-13-06
Date

REQUEST FOR RECONSIDERATION

In response to the Office Action dated March 14, 2006, review and reconsideration in view of the following remarks is respectfully requested.

Claims 1-7, 9-11 and 13-27 are pending in the application. Applicants thank the Examiner for the indication of allowable subject matter in claims 2-7, 9, and 16-22. For at least the following reasons, Applicants submit all pending claims are in condition for allowance.

Claims 26 and 27 are rejected under 35 U.S.C. 102(e) over U.S. 6,429,923 to Ueda et al. Applicants traverse the rejections for at least the following reasons.

It is asserted in the Office Action that Ueda et al. teaches all the features of the claimed invention as set forth in claims 26 and 27. However, as noted at page 11 of Applicants' last response, all of the features of claims 26 and 27 clearly and exactly correspond to the indicated allowed subject matter as recited at page 11 of the September 12, 2005, Office Action, and at page 10 of the current Office Action.

The following table compares the language of the current Office Action, page 10, regarding the reasons for allowance of claims 2-7, 9, and 16-22, with the language of claims 26 and 27.

<p>“...The prior art does not teach the method of</p> <p>transporting a portable imaging system to a first location;</p> <p>receiving a hardcopy document from a user at the first location, the hard copy document containing the visual image;</p> <p>scanning the hard copy document at the first location using the portable imaging system to produce a digital image;</p> <p>and transporting the portable imaging system, to a second location remote from the first location.”</p>	<p>26. (previously presented) A method of producing a print from a visual image, comprising the steps of:</p> <p>transporting a portable imaging system to a first location;</p> <p>receiving a hard copy document from a user at the first location, said hard copy document containing the visual image;</p> <p>scanning the hard copy document at the first location using the portable imaging system to produce a digital image; and</p> <p>transporting the portable imaging system to a second location remote from the first location.</p>
<p>“Furthermore, the prior art does not teach the method of sequentially</p> <p>transporting a portable imaging system from a first location;</p> <p>accessing the image to be digitized at the second location;</p> <p>scanning the image at the second location using the portable imaging system</p> <p>and storing the digital image in memory disposed in the portable imaging system and</p> <p>generating an order request associated with the stored digital image.”</p>	<p>27. (previously presented) A method of digitizing an image, comprising the steps of sequentially:</p> <p>transporting a portable imaging system from a first location to a second location;</p> <p>accessing the image to be digitized at the second location;</p> <p>scanning the image at the second location using the portable imaging system to produce a digital image;</p> <p>storing the digital image in memory disposed in the portable imaging system; and</p> <p>generating an order request associated with the stored digital image.</p>

As can be seen from the comparison, claims 26 and 27 use the exact language of the Patent Office, and include every feature indicated by the Patent Office to be patentable over the prior art. For at least the above reasons, the rejection of claims 26 and 27 over Ueda et al. must be reconsidered and withdrawn.

Claims 1, 10, 11, 13-15 and 23-25 are rejected under 35 U.S.C. 103(a) over U.S. 6,429,923 to Ueda et al. Applicants traverse the rejections for at least the following reasons.

Ueda et al. does not disclose or suggest all the features of the rejected claims. As exemplary claims, Applicants will discuss independent claims 1, 10, and 11, from which all other claims depend.

The Patent Office asserts the same portions of Ueda et al. against claims 1, 10, and 11. However, the characterizations of at least some of these sections are incorrect. For example, it is stated repeatedly in the Office Action that "The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system from a first location to a second location." Transportation and installation of a system does not indicate portability. Anything can be transported and installed given large enough equipment. For example, houses are transported in pre-built sections, and assembled on site. This does not make the house "portable" in the sense of the claimed invention. The claimed invention requires that the portable imaging device be of a size small enough for the service provider to carry the portable imaging device by hand, as set forth in claims 1, 10, and 11. In contrast, the Patent Office points to the wheels on Figures 3 and 5 of Ueda et al. Although Ueda et al. shows a wheeled device, as is evident from study of the scale of the device, it is not portable by hand.

The Patent Office asserts repeatedly "it was notoriously well-known in the art to reduce the size of image processing apparatus such as scanners as small as possible," indicating it would be obvious to reduce the size of the apparatus to something able to be carried by hand. While it may be convenient to make items smaller, the technology is not always present to do so, nor is it always reasonable to do so in view of the functionality of a given item. Ueda et al. teaches a printer processor 1 which includes a host computer 100, a film scanner 600, a flat bed scanner 170, electronic media readers 140 and 150, a monitor 190, and other features

as desired. There is no indication any of these features can be removed from the printer processor and retain functionality. Nor is there any teaching or suggestion how removing one or more of these features from the printer processor would be beneficial, as opposed to keeping all features in one integrated mechanism.

The Patent Office further asserts that Figure 9 and col. 71, lines 10-50 teach "that if the photo-shop is unable to perform all of the desired imaging services the images can be transmitted to the main photo-finishing center or a truck will arrive at the photo-shop and pickup the images and bring them to the photo-finishing processing center." Applicants respectfully assert the Examiner did not carefully review this portion of Ueda et al. This portion of the patent specification is entitled "Direct Delivery from Photofinishing System." The section of the specification discusses the "delivery system 740" of the "photofinishing system." In particular, it is stated at lines 12-18:

In the photographic product production/distribution system of the present embodiment, selling procedures are conducted on the occasion of order receiving, which makes it possible for the photofinishing system to directly deliver photographic products to an address of an orderer automatically. Due to this, the orderer can receive photographic products without visiting the delivery system 740.

The specification continues to state that when "a customer wishes to receive this service [direct delivery], information to the effect that direct delivery is desired is inputted in the order receiving system...." (lines 19-21). Once orders are prepared and bagged with information as to contact name, address, and phone number. This container is then transferred to delivery truck 842 "which delivers the container for delivery to the orderer whose name and where to make contact are recorded on the container for delivery. Then, the delivery truck 842 delivers photographic products directly or indirectly to the address of the orderer..." (lines 43-50). As is evident from this description, because the order is pre-paid, direct orderer delivery is possible upon formation of the photographic products. The "orderer" is the customer, as established at lines 19-24, not the shop.

As set forth in Ueda et al., orders can be entered on the host computer 100 of the printer processor 1 or on client computers 20, 30, or 40. However, all printouts are done on printer processor 1. See col. 33, lines 34-41, and col. 49, lines 45-50. The hard copy of the order is always output from printer processor 1. Printer

processor 1 is also the only device including a flat bed scanner 170 or film scanner 600. Such devices are not present in the client computers. Thus, scanning of a hard copy document and producing the corresponding image product always occurs within printer processor 1. In contrast, Applicants' claimed invention scans with a portable imaging system, then forwards the digital image to a fulfiller for generation of the corresponding print.

With regard to claims 10 and 11, Applicants again note these claims require a fulfiller or a sponsor providing a credit to the service provider that scanned the images. The Office Action takes official notice that fee splitting arrangements are known in the art. However, the claims are not directed to fee splitting, but rather to payment of an incentive, or credit, to the service provider, which is separate from a fee for service rendered.

As discussed above, Ueda et al. fails to disclose or suggest at least transporting a portable imaging device; that a portable imaging device can be of a size to be carried by hand; providing a digital image to a fulfiller; or either a fulfiller or a sponsor issuing a credit to a service provider. Thus, Ueda et al. does not disclose or suggest every feature of the claimed invention as set forth at least in claims 1, 10, 11, 13-15, and 23-35.

All of claims 1-7, 9-11 and 13-27 being in condition for allowance for at least the above reasons, reconsideration and prompt action in the form of a Notice of Allowance are respectfully solicited. Should the Examiner require anything further, or have any questions, the Examiner is asked to contact Applicants' undersigned representative.

Respectfully submitted,



Kathleen Neuner Manne
Attorney for Applicant(s)
Registration No. 40,101

KNM:kjw
Rochester, NY 14650
Telephone: (585) 722-9225
Facsimile: (585) 477-1148

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.